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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/826,690	04/05/2001	Joseph Harbaugh	6994-1	4205
86002	7590	03/02/2010	EXAMINER	
J. Rodman Steele			CASLER, TRACI	
Novak Druce & Quigg LLP			ART UNIT	PAPER NUMBER
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Suite 1500			3629	
West Palm Beach, FL 33401				
MAIL DATE		DELIVERY MODE		
03/02/2010		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.



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MAR - 2 2010

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Novak, Druce & Quigg, LLP  
525 Okeechobee Blvd.  
Suite 1500  
West Palm Beach, FL 33401

In re Application of  
Joseph Harbaugh  
Application No. 09/826,690  
Filed: April 5, 2001  
For: METHOD FOR ADMITTING AN ADMISSIONS  
APPLICANT INTO AN ACADEMIC INSTITUTION

DECISION ON THE PETITION  
REGARDING REQUEST TO  
WITHDRAW FINALITY

Applicant's petition filed under 37 CFR 1.182, filed January 26, 2010, requests the removal of the examiner from the above-noted application due to a perceived examiner bias in it's prosecution, and is being treated as a petition for Supervisory Review under 37 CFR 1.181.

The petition is DENIED.

A review of the file record indicates that the application was initially filed on April 5, 2001 with subsequent Office actions and applicant responses leading up to the most recent action being a Final rejection dated December 7, 2009.

Initially, applicant argues that the examiner the Office action of April 25, 2005 indicated that "there must be admission before the student can take courses". This quote is not found in paragraph 50 as indicated by the applicant. The examiner did indicate that some type of admissions process is needed regardless if the classes they are taking are credit or non-credit, but this is very different than the statement the applicant attributes to the examiner. It appears that applicant has altered the examiner's statement and taken it out of context. Plus, it is nothing more than a response to applicant's argument and not evidence of bias.

Applicant next argues that the examiner indicates that the "facts examiner needs to rely on for official notice were taking place long before the examiner was in the field in 1999". Applicant goes on to say that the examiner has failed to identify a single reference supporting her assertion of Official notice despite applicant's request for her to provide supporting evidence. It is not clear where the above statement applicant indicates that the examiner has made resides, but it does not appear to be present in the response to applicant's arguments portion of the above action. Furthermore, a review of the Office action finds that the examiner took no Official Notice. Each and every claim limitation appears to be rejected using prior art, so it is unclear as to what Official notice the applicant is referring to. Also, the follow-up response to the above noted Final rejection (filed August 24, 2005) failed to request the examiner provide any evidence supporting assertions of Official notice.

As to the holding by the examiner that the secondary consideration of admitting minorities into law school is not persuasive, the examiner's holding that these secondary considerations are not persuasive due to a lack of a nexus between the disclosed invention and the purported evidence of long felt need and commercial success is not seen as arbitrary or capricious.

Applicant argues that the examiner, in the Office action of November 4, 2005, improperly draws upon her own experiences as an admissions counselor (taking Official notice) in order to teach the limitation to purchase or gain access to a list of students in a particular category in order to target enrollment. However, besides showing skepticism over the examiner's claims, applicant has not explained how this is evidence of bias. Again, nowhere in the follow-up response to the above noted non-final rejection (filed May 3, 2006) is applicant seen to request the examiner provide any evidence supporting assertions of Official notice.

Applicant also argues that the examiner directly contradicts the Shelton declaration. Just because the examiner is not persuaded by the declaration does not mean that she is contradicting it. The examiner considered the declaration and was not persuaded by it, and explained the reasons why it was not persuasive. Disagreement with an applicant's arguments, secondary considerations and supplied declarations is not evidence of improper bias.

In the Office action of July 27, 2006 the applicant accuses the examiner of "sarcastically musing as to why an institution would focus on students who sought admission elsewhere but did not meet standardized tests". Also, the applicant takes issue with the examiner's holding that the showing of commercial success lacks evidence that the students identified by the invention are actually successful at the institution in which they are ultimately enrolled. Apparently the examiner is questioning the assertion that the method is "unrivaled at finding diamonds in the rough". Clearly, to base patentability on secondary considerations such as commercial success and/or long felt need the examiner has every right to demand that there be a clear nexus between the claimed invention and any purported commercial success or satisfaction of a long felt need. When a claimed invention is otherwise taught by the prior art, it is the burden of the applicant to provide a persuasive showing of secondary considerations. Again, the examiner failing to be persuaded by the showing by the applicant is not evidence of bias.

Applicant also takes issue with the manner in which the examiner interprets the term "enrolled". The examiner is entitled, if not actually mandated, to use the broadest reasonable interpretation of claim language in the examination of the claimed invention.

Applicant further argues that, in the Office action of August 23, 2007, the examiner's holding of the claims being obvious based solely upon a declaration made by the examiner was clearly improper. It is noted that the applicant's claims, in addition to the above-noted examiner declaration, were also rejected under 35 USC 102(b) by a first piece of prior art, as well as under 103(a) by a second piece of prior art. It is also noted that the rejection made using the examiner declaration was withdrawn in the following Office action. Again, disagreement with a rejection made by an examiner is not evidence of bias.

Applicant next takes issue with an Office action dated March 8, 2008. Because there was no action mailed March 8, 2008, it is assumed that the action referred to is actually intended to be the Office action of May 22, 2008. The applicant takes issue with the holding of Official Notice taken by the examiner. The applicant finds "these instances to be particularly egregious because the examiner provides no support for the taking of official notice despite the fact applicant challenges the examiner's taking of official notice and requests documentary evidence supporting the examiner's position...". It is noted that a document was provided that supported the holding of Official notice in paragraph 15 of the Office action of May 22, 2008.

In the Office action of December 7, 2009, the applicant takes issue with the reference provided by the examiner in support of the holding of Official notice. The applicant continues to argue that the examiner's reading of the art is improper as is her application of the holding of Official notice. All of these issues go to the merits of the rejections made in the December 7, 2009 Office action and are not procedural in nature. As such, they are seen as appealable, not petitionable, and will not be further addressed here.

In conclusion, the standards for removing an examiner from an application due to examiner bias is a clear and convincing showing of behavior which is arbitrary and capricious with regard to the procedures used in the prosecution of the application in question. Nothing rising anywhere near this level has been shown to exist here. Certainly there have been many disagreements as to what references teach, what the scope of the claims actually are, and if the interpretations of the art and claimed invention by the examiner are proper. However, none of this shows anything more than the common difference of opinion that occurs regularly between an examiner and an applicant in the prosecution of a patent application. These disagreements go to the merits of the of the prosecution and are proper for decision on appeal.

No arbitrary or capricious behavior by the examiner has been shown by the applicant that would lead to a conclusion of improper bias exhibited by the examiner toward the applicant or applicant's application.

The petition for the removal of the examiner from this application of January 26, 2010 is **DENIED**.

Any questions or comments with respect to this decision should be forwarded to Quality Assurance Specialist Steven N. Meyers at (571) 272-6611.



Wynn Coggins, Director  
Patent Technology Center 3600  
(571) 272-5350

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